

REMARKS

In an Office Action mailed on September 13, 2006, claims 1, 6-9, 15, 21, 27 and 28 were rejected under 35 U.S.C. § 102(b) as being anticipated by Retz; claims 16 and 17 were rejected under 35 U.S.C. § 102(b) as being anticipated by McCullough; claim 32 was rejected under 35 U.S.C. § 102(b) as being anticipated by Mouton; claims 49 and 53 were rejected under 35 U.S.C. § 102(b) as being anticipated by Gore; claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Retz in view of Gore; claims 43, 44 and 46-48 were allowed; and claims 18-20, 22-26, 33-42, 46, 47, 50-52, 54 and 55 were objected to as being dependent upon rejected base claims but were indicated as being allowable if rewritten in independent form.

Limitations of claims 50 and 54 (now cancelled) have been incorporated into independent claims 49 and 53, respectively. For at least the reason that the Examiner indicated that claims 50 and 54 were patentable if rewritten in independent form, allowance of claims 49, 51-53 and 55 is requested.

Regarding the § 102 rejection of independent claim 1, as amended, the method of claim 1 includes deploying a spring downhole; energizing the spring before running the spring downhole; and in the well, causing the spring to radially expand using energy stored in the spring and without transferring additional energy to the spring.

Contrary to the limitations of amended claim 1, Retz discloses an "actuator means" that is activated downhole in the well to move pushing rods 60 and movable mount 58 downwardly to radially expand pressing elements 54 into engagement with a liner 66. Retz, 8:8-11. Thus, even assuming, *arguendo*, that Retz's pressing elements 54 store energy prior to the associated assembly being deployed into the well, additional energy is supplied in the well (through the actuator means) for purposes of causing the pressing elements 54 to expand. Thus, Retz fails to anticipate claim 1.

The apparatus of independent claim 21 has been amended in a similar manner to recite a spring that is adapted to be energized before being run into a well and in the well, release energy stored in the spring to cause the spring to radially expand to form an annular barrier in the well without the spring receiving additional energy to aid the expansion.

For at least the reason that the pressing elements 54 of Retz receive additional energy via the actuator means for purposes of expanding the elements 54, Retz fails to anticipate amended claim 21.

Claims 2, 6-9, 15, 27 and 28 are patentable for at least the same reasons as independent claims 1 and 21.

Regarding the § 102 rejection of independent claim 16, claim 16 recites forming a helical groove in a tubular member to form a spring.

Contrary to claim 16, McCullough discloses a plug that may be formed from a metal. McCullough does not, however, teach or suggest that the plug has any spring-like properties. As previously pointed out by Applicant, McCullough states that the body anchors "the plug very strongly against slippage or displacements by any loads which would subsequently supported thereon." McCullough, 2:63-66. McCullough fails to disclose a mechanism to hold the plug 10 in its deformed shape, thereby implying that the plug 10 is formed from a metal that does not have a memory of its prior non-deformed shape, which is contrary to the plug 10 possessing spring-like properties. Therefore, for at least these reasons, a *prima facie* case of anticipation has not been set forth for independent claim 16.

A *prima facie* case of anticipation has not been set forth for claim 16 for at least the additional, independent reason that equivalency is improperly relied on in a Section 102 rejection to show an otherwise missing claim element. Contrary to such a view, no such legal proposition exists, and there is no justification for such a proposition. *Richardson v. Suzuki Motor Co. Ltd.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989) (holding "the jury had erroneously been instructed that anticipation may be shown by equivalence, a legal theory that is pertinent to obviousness under Section 103, not to anticipation under Section 102"). Thus, the Office Action fails to set forth a *prima facie* case of anticipation in view of McCullough regardless of whether or not the plug 10 has spring-like properties.

Therefore, for at least any of the reasons set forth above, withdrawal of the § 102 rejections of claims 16 and 17 is requested.

Independent claim 32 has been amended to recite that a spring is adapted to expand to form an annular barrier in the well to seal an annulus of the well. The centralizer of Mouton, as recognized by the Examiner, does not form such an annular seal. Therefore, for at least this reason, amended claim 32 overcomes the § 102 rejection.

CONCLUSION

In view of the foregoing, withdrawal of the remaining §§ 102 and 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0317US).

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Respectfully submitted,

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